

REMARKS

This amendment to the above-identified application is made in response to the first Official Action, identified as Paper No. 3 and dated December 28, 1998. In the action, the sole claim of the application as originally filed was rejected under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,503,380 to Derby in view of U.S. Patent No. 5,647,129 to Stamper. The application as amended and supported by these accompanying remarks is believed to overcome the rejections and place the present application into condition for allowance. Accordingly, the Examiner's reconsideration is respectfully requested.

1. §112 Rejections

With regard to the §112 rejections, the two "means plus function" clauses originally present in claim 1 have been canceled and replaced by a "whereby" clause. As the supporting structures for both "means" clauses have been recited in the body of claim 1 (i.e., the holes formed through the housing's sidewall and the cover plate's protrusions which engage one or the other of the holes when the cover plate is in its terminal open and closed positions), a whereby clause has been added to provide reference to the "locking" function this structure provides. Accordingly, the "means plus function" clauses would be superfluous and thus have been appropriately canceled from the claim. Consequently, withdrawal of the §112 rejection pertaining to the "means" clauses is respectfully requested.

Claim 1 has further been amended to delete the adjective "ancillary" modifying "tools" and replace it with "elongated." Antecedent support for "elongated" is found in line 8 of claim 1. With regard to the lack of antecedent basis rejection of "first and second slots formed transversely across each of said top and bottom edges," it is respectfully submitted that no basis

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is needed for this instance of "first and second slots" as this is a positive recitation of these elements in the body of claim 1, not a mere recitation of structural support to a different, positively recited element. With respect to "said top and bottom edges," antecedent basis is provided in lines 8 - 9 of claim 1. Accordingly, the Examiner's reconsideration and withdrawal of this §112 rejection is respectfully requested.

2. §103 Rejection

Claim 1 has been further rejected under 35 U.S.C. §103 over Derby in view of Stamper. In paragraph 3(a) of the Action, Derby is described as disclosing a multiple purpose pocket tool having "an elongated housing (11), a plurality of elongated tools (43) and an elongated cover plate with an inward protrusion (10) and a flange (17), a means for locking cover plate in its terminal open and closed positions (Fig. 7) achieved through contact among elements (10, 12, 17, & 11)." Stamper was relied on for its disclosure of first and second slots formed in the top and bottom edges, respectively, of the blade. The Examiner's stated conclusion is that it would have been obvious to one of ordinary skill in the art to have modified Derby by providing first and second slots in the tools.

a. No prima facie case of obviousness

The Examiner has mistakenly attributed structural attributes to Derby which are not present. While Derby certainly discloses a housing 11 for holding a plurality of elongated tools 43, and a cover plate 10 pivotally connected to the housing, it does not disclose:

1. An inwardly directed protrusion formed on one of the cover plate's sidewalls (the Examiner indicates that protrusions are denoted in Derby by reference number 10. However, "10" designates the cover plate; no protrusions exist on the cover plate); or
2. First and second apertures formed through one sidewall of the housing, adjacent its

first end (no corresponding reference to these claimed apertures were indicated in the Action).

Nor does any other prior art reference disclose these particular structural features.

Both of these structural features are positive elements of claim 1 of the present application: element (1) above being recited in line 16 of claim 1 as originally submitted and element (2) above being recited in lines 6 - 7 of claim 1 as originally submitted. Moreover, the cooperation of these particular structural elements perform an important function; namely, locking the cover plate in its terminal open and closed positions as recited in the "whereby" clause added to claim 1 by the instant amendment. Accordingly, the lack of the referenced and claimed structure in Derby, or any other prior art reference, patentably defines the instant invention over the prior art.

b. Amendments to claim 1 provide additional patentable distinctions over the prior art

Claim 1 has been amended to clearly recite the structural relationship between the cover plate's flanged end and the slots formed in the elongated tools; the relationship being the flange engaging either of the first and second slots of each of the elongated tools when the cover plate is in its terminally closed position (the position of the "terminally closed position" recitation in claim 1 has also been changed to provide proper antecedent basis for the recitation of the structural relationship presently being discussed). With the addition of this new language in the claim, there is no motivation for altering the Derby tools with that of Stamper because neither Derby nor Stamper include a cover plate having a flange that will engage the slots of all tools when the cover plate is in its terminally closed position. This lack of motivation renders an obviousness type rejection inappropriate. Accordingly, claim 1 as amended includes this further patentably distinct elements over the prior art.


3. Added claims

The instant amendment has added claims 2 - 16, all of which are ultimately dependant from claim 1. As claim 1 is now believed to be patentably distinct over the prior art, and claims 2 - 16 are all believed to be written in appropriate form, consideration and allowance of claims 2 - 16 is respectfully requested.

Conclusion

In view of the foregoing amendments, as supported by these accompanying remarks, reconsideration and allowance of the instant application is deemed appropriate and is respectfully requested. Should the Examiner have any questions regarding the patentability of the claims or require correction of any informalities, he is respectfully urged to phone the undersigned attorney at (315) 471-3151 to expedite the prosecution of the present application.

Respectfully submitted,
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I hereby certify that this correspondence is being placed with the U.S. Postal Service as First Class Mail on this March 29, 1999 addressed to Assistant Commissioner for Patents, Washington D.C. 20231


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